



Attorney Docket No. G3752

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Marco STEIGER et al.
Serial No. 09/917,998
Filed 07/30/2001
For MATERIAL REMOVING TOOL
Examiner Ms. Shantese L. McDonald
Group Art Unit 3723

BRIEF ON APPEAL UNDER 37 CFR §1.192

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Sir:

This Brief seeks a reversal of the second final rejection (following a first final rejection which followed a withdrawal of notice of allowance) of claims which are presently active in this case, namely the claims 1-11 and 13-21. Copies of the finally rejected claims are enclosed.

The prescribed fee in the amount of \$160.00 is enclosed.

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(1) REAL PARTY IN INTEREST

The real party in interest is the assignee of the present application, namely Ylinia A.G., a Corporation organized and existing under the laws of the Principality of Liechtenstein and having its principal place of business at Gogoz 73, FL-9496, Balzers, Liechtenstein. The assignment was recorded on December 22, 2000, Reel/Frame 011408/0245.

(2) RELATED APPEALS AND INTERFERENCES

Appellants and/or their assignee did not file any appeals and they are not involved in any interferences which are related to this proceeding.

(3) STATUS OF CLAIMS

Claims 1-11 and 13-21 are pending in this application. All claims stand finally rejected. The last (emphasis by the undersigned attorney) final rejection is dated August 19, 2003.

(4) STATUS OF AMENDMENTS

An amendment under §1.116 of Title 37 CFR was filed on June 20, 2003 in response to the first Final Action dated May 20, 2003. The amendment was misplaced at the Patent Office and a copy thereof was sent by facsimile to the Examiner Ms. Shantese L. McDonald (namely to her private fax number) on August 7, 2003. The Examiner responded with a corrected Final Action on August 19, 2003.

(5) SUMMARY OF INVENTION

1. One feature of the invention resides in the provision of a tool (such as the tool 11 shown in Figs. 1 to 4) which serves to make cuts in workpieces (e.g., in workpieces made at least in part of wood, plastic or metallic or concrete material), namely to make cuts which are bounded by walls. Certain typical examples of cuts which can be obtained by resorting to the tool of the present invention are discussed in the paragraph bridging the pages 17-18 of appellants' specification. The tool 11 can be manipulated by resorting to a manually operable apparatus (such as the apparatus 1 of Fig. 1) having a power-driven output shaft 7 which is ar-

ranged to oscillate about a predetermined axis A. The heretofore outlined features of the tool 11 are pointed out in the preamble of the independent claim 1.

The tool 11 of Figs. 1-4 comprises an elongated member 15 (e.g., a substantially plate-like member) having (a) a first section (the upper section, as viewed in Fig. 3) which is arranged to be mounted (such as by the tool fastening means 9 of Fig. 1) on the output shaft 7 of the apparatus 1 so that the member 15 extends in a direction (substantially horizontally, as viewed in Fig. 1) which is at least substantially normal to the predetermined axis A, and (b) a second section (namely the lower section of the member 15, as viewed in Fig. 3) which is remote from the first section and includes at least one at least substantially straight cutting edge 13 which is at least substantially normal to the aforementioned direction and is arranged to make in a workpiece (e.g., in or adjacent a door- or window frame) a cut having a width which is a function of (i.e., dependent upon) a plurality of parameters including: (i) the extent of oscillatory movement $H/2$ of the output shaft 7, (ii) the distance L from the axis A to the cutting edge 13, and (iii) the length B of the cutting edge 13. As pointed out, for example, in lines 14-17 on page 7 of the specification, the improved tool

can perform a cutting action in a plane which is parallel to a surface of a workpiece and thus to form rectangular recesses or cuts even in the corners of workpieces.

The claim 2 recites that the cutting edge (such as 13) can be provided with material removing elements selected from the group consisting of cutting and grinding elements. This is fully described in lines 10-14 on page 9 of the specification.

The claim 3 recites that the material removing elements of the cutting edge (such as 13) can comprise teeth. This is disclosed, for example, in line 22 on page 14 of the specification and is shown, for example, in Figs. 3, 5 and 6 of the drawing.

The claim 4 recites the feature which is disclosed, for example, in line 23 on page 14 of the specification.

The claim 5 recites the feature which is disclosed, for example, in line 24 on page 14 of the specification.

The claim 6 calls for the feature which is shown (at 13c) in Fig. 7 and is described in the paragraph bridging the pages 16-17 of the specification.

The claims 7 and 8 refer to the claim 6 and recite features which are discussed in lines 18-25 on page

16 of the specification.

The claim 9 recites the feature which is described, for example, in lines 1-5 on page 15 of the specification.

The claim 10 refers to the claim 9 and recites the feature which is shown in each of Figs. 1-3 and 5-12 and is described, for example, in lines 16-17 on page 18 of the specification.

The claim 11 depends from the claim 10 and recites the feature which is specifically shown in each of Figs. 3-4 and 8-13, namely that the elongated member (such as 15) is provided with a step (such as the step 17 shown in Fig. 4) of finite length which is disposed between the aforementioned first and second sections of the member 15 and has a predetermined height h. This claim further recites the fastener (such as 9) which serves to attach the first section of the member 15 to the shaft 7 and extends beyond the elongated member 15 through a distance which at least approximates the height h of the step 17. Please refer, for example, to lines 4-5 on page 15 of the specification.

2. Another feature of the present invention resides in the provision of a tool of the type recited in claim 21 and shown, for example, in Figs. 5-7 and 10. This claim calls for a tool which is or which can

be identical with or similar or analogous to the tool of claim 1 and which further comprises means (such as the elongated slot 19 shown in Fig. 5) for facilitating removal of material from a workpiece being cut by the cutting edge (13a in Fig. 5). The advantages of such material removal facilitating means are described, for example, in the passage beginning in line 19 on page 15 and ending in line 11 on page 16 of the specification.

The claim 13 refers to the claim 21 and is readable on the embodiments of Figs. 5 and 10, namely on a tool wherein the material removal facilitating means comprises at least one elongated slot (19 or 19c) in the elongated member. Please refer, for example, to lines 21-22 on page 15 of the specification.

The claim 14 also refers to the claim 21 and is readable on the embodiments of Figs. 6, 7, 10 and 11, namely upon a tool wherein the elongated member has material removal facilitating means in the form of recessed portions (at 17b in Fig. 6) at the ends of the cutting edge (13b) intermediate the first and second sections of the elongated member of the cutting tool (11b). Please refer, for example, to lines 2-11 on page 16 of the specification.

The claim 15 is dependent upon the claim 1 and

recites that the elongated member (such as the member of the tool 11a shown in Fig. 5) has an at least substantially constant width between its first and second sections. Please refer to lines 22-23 on page 15 of the specification.

The claim 16 also refers to the claim 1 and is specifically readable on the embodiments of Figs. 1-4, 8 and 9, namely upon a tool wherein the elongated member (such as 15) has a substantially trapeziform outline. Please refer to lines 1-2 on page 15 of the specification.

The claim 17 is dependent upon the claim 1 and is readable, for example, upon the embodiment of Figs. 1-4 wherein the third section 17 of the elongated member 15 has a width different from that of the other two sections. This is described, for example, in the last four lines on page 9 of the specification.

3. The independent claim 18 recites a kit which comprises a plurality of tools of the type called for, by way of example, in the claim 1. This is described, for example, in the first paragraph on page 10 of the specification. The interchangeability (i.e., a feature typical of a kit of tools) of several tools, each of which embodies the present invention, is also disclosed in the first two paragraphs on page 19 and in lines 2-

9 on page 21 of the specification.

The claim 19 refers to the claim 18 and its matter is disclosed, for example, in the second paragraph on page 10 of the specification.

The claim 20 also refers to the claim 18 and its matter is disclosed, for example, in lines 20-24 on page 10 as well as in lines 7-8 on page 19 of the specification.

Numerous unobvious and hence novel features and advantages of the improved tool and tool kit will be even more readily appreciated upon perusal of the passage beginning in line 5 on page 20 and ending in line 9 on page 21 of appellants' specification. This passage points out several uses of a tool which, at a first glance, could be said to amount to not much more than a plate with one or more cutting edges at one end and a hole at the other end. However, once the improved tool is attached to and moved by an apparatus of the type called for in the preamble of each of the independent claims 1, 18 and 21, it can perform work that cannot be performed by presently known tools. In addition, the attachment of the tool to and its detachment from the apparatus are simple undertakings which can be readily performed by workmen having average skill in the relevant art, and such manipulations can

be performed rapidly and without the need for special tools. Still further, and as fully described in the specification (for example, in lines 17-19 on page 20), the manipulation of the improved tool involves the exertion of minimal effort because the tool tends to penetrate into the material to be slotted or similarly treated in response to the exertion of a surprisingly small force.

(6) ISSUES

The issues to be reviewed by the Board include (A) the handling of the present application from the filing date to the date of the second Final Action, (B) the ability of the Examiner in charge of the present application to interpret the case law and the language of claims in US patent applications, (C) the ability of the Examiner to interpret the prior art, (D) the ability of the Examiner to properly apply the prior art to the claims which are pending in the present application, and (E) the propriety of the (second) Final Action (Paper No. 14).

(7) GROUPING OF CLAIMS

As set forth in the second Final Action, the claims 1-3, 6, 9, 10, 13, 15-17 and 21 stand finally rejected under 35 U.S.C. 102(a) as being anticipated by the disclosure in US patent No. 6,022,353 to Fletcher et al. (hereinafter Fletcher).

The claims 4 and 5 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Fletcher and US patent No. 6,058,923 to Arntz et al. (hereinafter Arntz).

The claims 7 and 8 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher.

The claim 11 stands finally rejected under 35 U.S.C. 103(a) as being unpatentable over the combined disclosures of Fletcher and US patent No. 5,697,835 to Nitz et al. (hereinafter Nitz).

The claim 14 stands finally rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Fletcher and US patent No. 5,306,285 to Miller et al. (hereinafter Miller).

The claims 18-20 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Fletcher and US patent No. 5,427,188 to Fisher.

(8) ARGUMENT

Each of the claims 1-11 and 13-21 which are active in this case stands finally rejected as being unpatentable over Fletcher, either under 35 U.S.C. 102(b), or under 35 U.S.C. 103(a) over Fletcher alone or over Fletcher in combination with one of the aforementioned secondary references.

Fletcher discloses a surgical saw blade which appears to have little, if anything, in common with the tool or tool kit recited in appellants' finally rejected claims 1-11 and 13-21. The surgical saw blade which is disclosed and claimed by Fletcher is to be used in combination with a surgical bone saw (please refer to lines 1-2 of claim 1 in the patent to Fletcher). Thus, the teaching of Fletcher evidently departs from the teaching in the preamble of each of appellants' independent claims 1, 18 and 21. As concerns the claim 1, this claim calls for a tool which is to make in a workpiece cuts that have predetermined widths and that are bounded by walls. The claim 18 calls for a tool kit, a feature which is utterly lacking in the disclosure within the four corners of the Fletcher reference. Thus, the preambles of appellants' claims 1 and 18 evidently distinguish over the teaching of Fletcher because

this reference fails to disclose and/or claim a tool or a kit of tools destined to make in workpieces cuts (such as slits) having predetermined widths and being bounded by walls.

In the amendment of March 20, 2003, appellants relied on the decision by the CA FC in **Diversitech Corp. v. Century Steps, Inc.** (850 F.2d 675, 7 USPQ2d 1315, decided in 1988). In the Final Action of August 19, 2003, the Examiner relied upon the CCPA decisions **In re Casey** (152 USPQ 235, decided 1967) and **In re Otto** (136 USPQ 458, decided 1963) which are believed to be superseded by the aforementioned decision in **Diversitech Corp. v. Century Steps, Inc.** wherein it was held that:

"The district court correctly found that the preamble of the claim was necessary to give meaning to the claim and therefore constituted an essential limitation in determining whether the claim was anticipated."

Another decision which is believed to be relevant in the present case and which supersedes the aforementioned decisions being relied upon by the Examiner is **Corning Glass Works v. Sumitomo Electric U.S.A.** (868.F2d 1251, 9 USPQ2d 1962, Fed. Cir. 1989) wherein it was held that

"The district court correctly interpreted the preamble in the claim in suit -- "an optical waveguide" -- as a structural limitation rather than a statement of purpose."

Appellants were first to propose the combination of a tool of the type called for in the finally rejected independent claims 1 and 21 with a manually operable apparatus having a power driven output shaft (which shaft is arranged to oscillate about a predetermined axis) to make in workpieces cuts having predetermined widths and being bounded by walls. In other words, appellants provide a contrivance which, in clear contrast to a bone saw of the type called for in the patent to Fletcher, can perform work entirely different from that contemplated by Fletcher for the patented tool.

The Examiner's arguments on page 6 of Paper No. 14 dated August 19, 2003 are believed to be plainly erroneous. Please note that the Examiner relies on her CCPA 1963 and 1967 decisions against the patentability of process (emphasis by the undersigned) claims. On the other hand, the present application does not contain any process claims. As concerns the Examiner's assertion that "any object that makes cuts, would perform this limitation" (namely of the cutting edge being arranged to make in a workpiece a cut having a width which is a function of several parameters), appellants respectfully submit that a cutting edge cannot perform a "limitation". It is very difficult to comprehend a Final Action which appears to be written in inept langu-

age. According to Webster's Third New International Dictionary, a "limitation" is something, such as time, restriction or restraint, that is imposed or assigned; an exception to usual values; a restrictive weakness or lack of capacity, etc.

Fletcher is concerned with the severing of bones, i.e., with the making of a "kerf". According to Webster's Dictionary, the primary meaning of the term "kerf" is --a slit or groove or notch-- which is evidently plainly different from the making of cuts having predetermined widths and bounded by walls. Nothing within the four corners of the Fletcher reference is even remotely suggestive of employing the patented tool for the making of cuts having predetermined widths and bounded by walls. All Fletcher actually suggests is to separate (emphasis by the undersigned) a bone into discrete parts, i.e., to cut a piece of bone from the remaining part of the bone. Please refer, for example, to col. 3, line 47 of Fletcher where the patentees state that the patented tool is designed to cut "through the bone quickly". In this connection, appellants respectfully invite attention to the 1985 decision by the CA FC in **Fromson v. Advance Offset Plate, Inc.** (225 USPQ 26-27) wherein it was held that

"It is at best bizarre to assert that subject matter claimed by patent was merely

extension of existing technology when none skilled in the art attempted such extension during seven years when alleged economic advantages of such technology were available."

Please note that the first application for the patent to Fletcher was filed in the year 1991.

Still further, appellants believe that they can rely on another part of the decision by the CA FC in **Corning Glass Works v. Sumitomo Electric U.S.A.**, namely on that part where the Court held:

"it is entirely proper to use the specification to interpret what the patentee meant by a word or phrase in the claim", and
"The district court correctly interpreted the preamble of the claim ... as a structural limitation on the scope of the claim rather than a statement of purpose."

Appellants' claims call for and appellants' specification discloses a tool or a kit of tools for making in workpieces cuts having predetermined widths and being bounded by walls. Such teaching cannot be found in the specification and/or in the claims of the Fletcher reference. This patent has an independent claim 1 directed to a "surgical saw blade for use in combination with a bone saw", and an independent claim 9 which calls for a combination of "a surgical bone saw and a bone saw" (sic!). It is strongly believed that such teaching is not suggestive of the matter of appellants' independent claim 1 and/or 18 and/or 21, even if such claims

are interpreted per se, and perhaps even more when these claims are interpreted with reference to appellants' specification. As evidenced by the aforescussed decisions by the CA FC (each such decision supersedes those being relied upon by the Examiner), reliance upon the preamble of the claim and/or upon the disclosure in the specification is entirely proper in judging upon the patentability of claims in a US patent or patent application.

The dependent claims which are active in the present case are believed to be patentable because they refer to the presumably patentable independent claims. Furthermore, at least some of the dependent claims are believed to be plainly patentable per se.

Referring to the dependent claim 2, the word "grinding" cannot be found within the four corners of the Fletcher reference. Please note that the claim 2 stands finally rejected as being anticipated by the disclosure in the patent to Fletcher. It is axiomatic that a rejection can rely upon 35 U.S.C. 102(b) only if each and every element of the rejected claim can be found and/or disclosed in a single reference. Examples of such interpretation of 35 U.S.C. 102(b) can be found, inter alia, in **C. R. Bard, Inc. v. M3 Systems, Inc.** (157 F.3d 1340, 48 USPQ2d 1225, Fed. Cir 1998) wherein

it was held that "a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device", and in **Brown v. 3M** (265 F.3d 1349, 60 USPQ2d 1375, Fed. Cir 2001) wherein the Court pointed out that "To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim".

The rejection of claims 21 and 13 as being anticipated by the disclosure in the patent to Fletcher is believed to be erroneous. These claims call for "means for facilitating removal of material from a workpiece being cut by said cutting edge", and such means is recited as a separate or discrete constituent of the claimed tool, i.e., in addition to the cutting edge. The disclosure of Fletcher contains the statement that the removal of material from the kerf is carried out by the teeth at the cutting edge (please refer to lines 30-32 in col. 6 of the Fletcher patent). If the Examiner intends to rely on the "diamond-shaped cutout" 24 of Fletcher, appellants respectfully draw attention to col. 4, lines 42-49 of the reference where the patentees explain that this cutout serves to reduce the weight of the blade and to assist in tooth profiling during fabrication. As concerns the claim 13, please

note that this claim calls for a material removal facilitating slot, whereas Fletcher discloses a "diamond shaped cutout". Thus, it would appear that the final rejection of appellants' claims 13 and 21 as being anticipated by the disclosure in Fletcher is arroneous.

The claims 3, 6, 9, 10, 15, 16 and 17 are believed to be patentable because they refer to and thus share the features of the aforescussed claim 1.

The rejection of appellants' claims 4 and 5 as being unpatentable under 35 U.S.C. 103(a) over the combined teachings of Fletcher and Arntz is believed to warrant full reconsideration. The secondary reference fails to disclose or suggest those features of the claims 4 and 5 which are not disclosed and/or suggested by Fletcher, namely that industrial diamonds and/or corundum can be utilized in a tool of the type called for in appellants' claims 1 and 2 (the claims 4 and 5 refer to the claim 2). As fully expounded hereinbefore in connection with appellants' independent claim 1, Fletcher fails to disclose a tool which can be used or which has been recognized by Fletcher to be useful to make in workpieces cuts having predetermined widths and bounded by walls. Arntz teaches the use of diamonds and corundum on a sawblade body 2 which is a circular disc (col. 3, line 50). This alone is believed to suf-

fice to warrant withdrawal of Arntz from consideration in connection with the claims which are pending in the present case. A circular disc is not designed to be attached to the shaft of a manually operable apparatus in such a way that the disc will oscillate about a predetermined axis; on the other hand, this is a basic prerequisite for the utilization of appellants' tool and is recited in each and every claim of the present application.

The rejection of claims 7 and 8 as being unpatentable over Fletcher is believed to warrant reconsideration on the ground that these claims refer to the aforesaid claim 1 and also because the specific features which are recited in the claims 7 and 8 are evidently lacking within the four corners of the Fletcher reference. This is acknowledged by the Examiner in the paragraph bridging the pages 3 and 4 of the second Final Action (Paper No. 14). It is believed that the meaningless standard phrase ("It would have been obvious to one having ordinary skill in the art, etc., etc.") which is employed in the aforementioned paragraph in Paper No. 14, should be disregarded. Appellants have ascertained that the specific acute angles called for in their claims 7 and 8 are highly satisfactory for their purposes and, therefore, appellants be-

lieve that they can and should obtain patent protection therefor. Please note the very specific features which are called for in claims 6-8 and 10-12 of the patent to Fletcher. The US patent laws do not provide that each and every claim of a validly granted US patent must call for an invention of highest order. Thus, once an applicant has presented an independent claim, she or he can present a reasonable number of claims which refer to the independent claim and point out certain more specific features of the basic invention.

The rejection of claim 11 under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Fletcher and Nitz is also believed to warrant full reconsideration. Figs. 9 and 10 of Nitz show a circular cutting tool with a complete annulus of teeth, an annular intermediate portion (not referenced) and a raised central portion 84 with a mounting hole 86 for a drive shaft 87 which serves to rotate (not oscillate) the circular blade. Appellants' claim 11 calls for a step of finite length in contrast to the annular step which is shown in Figs. 9 and 10 of Nitz. Furthermore, appellants' step is disposed between two spaced-apart sections of an elongated member (claim 1) forming part of an oscillatory tool, whereas Nitz discloses an annular step between two ring-shaped sections of a rotat-

able tool.

Claim 14 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Fletcher and Miller. This rejection is believed to be plainly erroneous. Please note that appellants' claim 14 refers to the claim 21 which calls for a "means for facilitating removal of material from a workpiece being cut by said cutting edge", and that the claim 14 calls for a material removal facilitating means which comprises recessed portions at the ends of the cutting edge intermediate the first and second sections of the elongated tool. The patent to Miller does not point out the purpose (or any purpose) of the recessed portions shown in the tool which is depicted in Fig. 5B of this patent. Fig. 5B of Miller also shows openings (not referenced), but the specification of Miller fails to mention the purpose of such openings. The reason is that the patent discloses a saw blade wherein the teeth appear to be the only means for facilitating removal of material from the channel in a bone (please refer to lines 1-8 of column 4 in the patent to Miller).

The claims 18 to 20 stand finally rejected as being unpatentable under 35 U.S.C. 103(a) over the joint teaching of Fletcher and Fisher. These claims are di-

rected to the tool kit which is discussed in the last full paragraph on page 5, in lines 1-24 on page 10 and in lines 2-9 on page 21 of appellants' specification. Fletcher evidently fails to disclose or suggest a tool kit of the type called for in appellants' claims 18-20; otherwise, the Examiner would not be compelled to rely on the disclosure of Fisher. First of all, it is to be noted that, whereas the patent to Fletcher belongs to the US Class 606 (International Class A16B), Fisher belongs to US Class 173 (International Class B25D). Secondly, Fisher discloses a tool which is to perform reciprocatory movements in contrast to oscillatory movements which are to be carried out by the tool of Fletcher. Thirdly, the only independent claim (1) of Fisher calls for a "disc-shaped bore" (col. 5, lines 32-33) for a plurality of cam follower means, a feature which not only is incomprehensible even to a person who is thoroughly familiar with the English language and, if comprehensible, is evidently lacking in the invention sought to be protected with the claims 18-20 of the present application. In fact, the entire disclosure of Fisher is formulated in a manner which renders it practically impossible to comprehend the patented invention. For example, the lines 1-2 of the Abstract in the patent to Fisher call for a "portable power tool" which is in-

tended to form part of "a power tool". This appears to be tantamount to appellants' claiming a tool kit which forms part of a tool kit. In fact, even if one relies on her or his own best judgment and attempts to interpret the disclosure of Fisher as being directed to an invention wherein a drive means in a housing serves to transmit motion to any one of two or more scrapers, chisels, tool kits or the like, and which is operated in a manner as disclosed in lines 37-54 of column 1 in this patent, such invention appears to have no bearing upon the patentability of appellants' claims 18-20 irrespective of whether the teaching of Fisher is taken alone or in any proper or reasonably comprehensible combination with the teaching of Fletcher. Thus, whereas Fletcher employs a manually operable apparatus which is designed to impart to a tool an oscillatory movement, Fisher proposes a combination wherein the output shaft of a first power tool is supposed to impart to a second power tool a reciprocatory movement in order to carry out a scraping operation in contrast to the operation of a cutting edge employed by Fletcher and by the appellants. It is respectfully urged that the rejection of claims 18-20 as being unpatentable over the combined teaching of such utterly remote references be withdrawn in its entirety.

Last but not least, appellants respectfully draw attention to their Amendment under §1.116 of Title 37 C.F.R. (filed June 30, 2003 and refiled on August 7, 2003), and particularly to the paragraph (3) on pages 4-6 of such document. Thus, the prosecution of this case involved so many utterly unnecessary expenditures which, appellants believe, could have been avoided if the prosecution of the application would have been entrusted to another Examiner. The prosecution of a US patent application is a costly undertaking and; therefore, it is believed that an applicant is entitled to an examination which is not costlier than necessary solely as a result of numerous errors by the members of the US Patent Office. It is to be borne in mind that, since a US patent is granted for a certain number of years from the filing date, any unnecessary lengthening of prosecution of the present case involves a shortening of the patent term (provided, of course, that the Board will decide to reverse the Examiner's final rejection, either entirely or in part) plus additional expenses if the applicants seek to proceed in accordance with the provisions of any one of Sections 1.701 to 1.791 of 37 C.F.R., i.e., to seek an extension of the patent term.

(9) APPENDIX

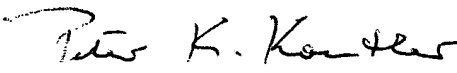
An Appendix in accordance with the provisions of 37 C.F.R. §1.192(c)(9) is enclosed.

A favorable consideration resulting in allowance of the claims 1-11 and 13-21 at a reasonably early date is earnestly solicited.

Respectfully submitted,

Enclosures:

- (1) Appendix
- (2) Check for \$160.00



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STATEMENTS OF THE CLAIMS INVOLVED IN THE APPEAL

1 1. A tool for making in workpieces cuts having
2 predetermined widths and bounded by walls with a
3 manually operable apparatus having a power driven output
4 shaft arranged to oscillate about a predetermined axis,
5 comprising:

6 an elongated member having a first section arrang-
7 ed to be mounted on said output shaft so that the member
8 extends in a direction at least substantially normal
9 to said predetermined axis; and

10 a second section remote from said first section
11 and including at least one at least substantially
12 straight elongated cutting edge at least substantially
13 normal to said direction and arranged to make in a work-
14 piece a cut having a width which is a function of the
15 extent of oscillatory movement of said output shaft,
16 of the distance from said axis to said cutting edge and
17 of the length of said cutting edge.

1 2. The tool of claim 1 wherein said cutting edge
2 is provided with material removing elements selected
3 from the group consisting of cutting and grinding ele-
4 ments.

1 3. The tool of claim 2, wherein said material
2 removing elements comprise teeth.

1 4. The tool of claim 2, wherein said material
2 removing elements comprise industrial diamonds.

1 5. The tool of claim 2, wherein said material
2 removing elements comprise corundum.

1 6. The tool of claim 1, wherein said at least
2 one at least substantially straight cutting edge
3 comprises two adjoining sections disposed at an acute
4 angle to each other.

1 7. The tool of claim 6, wherein said acute angle
2 is between about 1.5° and about 4.6° .

1 8. The tool of claim 7, wherein said acute angle
2 is between about 1.5° and about 2° .

1 9. The tool of claim 1, wherein at least a major
2 part of said elongated member is flat.

1 10. The tool of claim 9, wherein said first sec-
2 tion of said elongated member is provided with an aper-
3 ture for said shaft.

1 11. The tool of claim 10, wherein said elongated
2 member is provided with a step of finite length interme-
3 diate said first and second sections thereof, said step
4 having a predetermined height and further comprising
5 a fastener arranged to attach said first section to said
6 shaft and extending beyond said elongated member through
7 a distance at least approximating said height.

1 13. The tool of claim 21, wherein said removal
2 facilitating means comprise at least one slot provided
3 in said elongated member and extending between said
4 first and second sections.

1 14. The tool of claim 21, wherein said at least
2 one cutting edge has first and second ends and said re-
3 moval facilitating means comprises recessed portions
4 at said ends of said at least one cutting edge interme-
5 diate said first and second sections.

1 15. The tool of claim 1, wherein said elongated
2 member has an at least substantially constant width at
3 least between said first and second sections thereof.

1 16. The tool of claim 1, wherein said member
2 has a substantially trapeziform outline.

1 17. The tool of claim 1, wherein said elongated
2 member further comprises a third section disposed
3 between said first and second sections and having a
4 first width, at least one of said first and second sec-
5 tions having a second width different from said first
6 width.

1 18. A tool kit for removal of material from
2 workpieces with a manually operable apparatus having
3 a power-driven output shaft arranged to oscillate about
4 a predetermined axis, comprising a plurality of discrete
5 tools each including an elongated member having a first
6 section arranged to be non-rotatably and separably
7 mounted on said output shaft in a position in which said
8 member extends in a direction at least substantially
9 normal to said predetermined axis, and a second section
10 comprising at least one at least substantially straight
11 cutting edge at least substantially normal to said
12 direction upon mounting of the respective first section
13 on said output shaft.

1 19. The tool kit of claim 18, wherein said tools
2 have different parameters including at least one of the
3 widths, the distances between the first sections and
4 the cutting edges, and the lengths of the cutting edges
5 thereof.

1 20. The tool kit of claim 18, wherein at least
2 one of said tools has means for facilitating evacuation
3 of material being removed from a workpiece by the
4 cutting edge of the at least one tool in actual use of
5 the at least one tool.

1 21. A tool for removal of material from workpie-
2 ces with a manually operable apparatus having a power
3 driven output shaft arranged to oscillate about a prede-
4 termined axis, comprising:

5 an elongated member having a first section arrang-
6 ed to be mounted on said output shaft so that the member
7 extends in a direction at least substantially normal
8 to said predetermined axis;

9 a second section remote from said first section
10 and including at least one at least substantially
11 straight cutting edge at least substantially normal to
12 said direction and;

13 means for facilitating removal of material from
14 a workpiece being cut by said cutting edge.